



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,011	03/12/2004	Kai Igarashi	1232-5340	7570
27123 7590 05/01/2008 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
MATTIS, JASON E				
ART UNIT		PAPER NUMBER		
2616				
NOTIFICATION DATE		DELIVERY MODE		
05/01/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

# Office Action Summary

**Application No.**

10/799,011

**Applicant(s)**

IGARASHI ET AL.

**Examiner**

JASON E. MATTIS

**Art Unit**

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-17 and 29-31 is/are rejected.
- 7) ☒ Claim(s) 14 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_
- Paper No(s)/Mail Date 1 paper

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 recites the limitation "the administrative device" in lines 4-5. Although there is mention of "an administrative device" in claim 2, since claim 3 depends only on claim 1, there is insufficient antecedent basis for this limitation in claim 3. It is recommended that claim 3 be amended such that there is proper antecedent basis for the term "the administrative device".

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 11-13, 15, 17-20, 25-27, 29, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Eran et al. (U.S. Publication US 2004/0063455 A1).

**With respect to claims 1, 17, 25, and 31**, Eran et al. discloses a communication system including a connection device, which is an information processing device, operating a connection device designation method **(See the abstract, page 3 paragraph 36, and Figure 1 of Eran et al. for reference to a wireless LAN system 20 including an access point 22, which is a connection device and information processing device, operating a method to select an access point 22 that a mobile station 24 should connect to)**. Eran et al. also discloses a storing means storing and managing information pertaining to a connection device which a communication device should connect to **(See pages 4-5 paragraph 47 and Figure 2A of Eran et al. for reference to access points 22 receiving a probe request 40 from a mobile station 24, which is a communication device, and measuring the signal strength of the probe request, with the signal strength being information pertaining to an access point 22 which a mobile station 24 should connect to, meaning there inherently must be some storage with the access points 22 to receive the probe request and to stored the measured value of the signal strength)**. Eran et al. further discloses a determining means for determining a connection device which is connected to a first connection device and which the communication device should connect to based on information stored in the storing means **(See page 5 paragraph 48 and Figure 2A of Eran et al. for reference to manager 30, which includes a determining means, that**

**determines an access point 22, which is connected to the other access points 22 though hub 26 and manager 30, to which the mobile station 24 should connect to based on the signal strengths measured, stored, and sent to the manager 30 from multiple access points 22).** Eran et al. also discloses a notifying means notifying to the communication information for connecting to the connection device determined by the determining means **(See pages 5-6 paragraph 54 and Figure 2B of Eran et al. for reference to notifying the mobile station 24 of the MAC address of the selected access point 22 with the MAC address being information for connecting the to determined access point 22).**

**With respect to claim 2,** Eran et al. discloses an administrative device having the storing means **(See pages 3-4 paragraph 38, pages 4-5 paragraph 47, and Figure 1 of Eran et al. for reference to manager 30, which is an administrative device, receiving probe requests and signal strength indications from the access points 22, meaning the manager 30 must have some storage means to receive and store the information sent from the access points).** Eran et al. also discloses that the administrative device performs the determination performed by the determining means **(See page 5 paragraph 48 and Figure 2A of Eran et al. for reference to the manager 30 performing the selecting of the access point 22 that the mobile station 24 should connect to).**

**With respect to claims 3 and 18,** Eran et al. discloses performing the determination when the communication device performs an authentication process with the administrative device **(See page 5 paragraphs 49-50 and Figure 2A of Eran et al.**

**for reference to performing the selection along with an authentication process at the manager 30 whereby a response to an authentication request is sent from the selected access point 22 to the mobile station 24).**

**With respect to claims 4 and 19, Eran et al. discloses that the notifying information includes identification information for identifying the connection device (See pages 5-6 paragraph 54 and Figure 2B of Eran et al. for reference to the notifying information being the MAC address of the selected access point 22, which is information identifying the access point 22).**

**With respect to claims 5 and 20, Eran et al. discloses performing the determination based on user information pertaining to the user of the communication device (See page 5 paragraph 48 and Figure 2A of Eran et al. for reference to performing the access point selection based on signal strength indications, which is user information pertaining to the current signal strength of signals received by the access points 22 from the mobile station 24 of the user).**

**With respect to claim 11, Eran et al. discloses each connection device having the storage means and each connection device storing information pertaining to a communication device to which that device permits a connection (See pages 4-5 paragraphs 47-48 and Figure 2A of Eran et al. for reference to the probe request and signal strength information being received, measure, and stored at each access point 22, with the signal strength information being information pertaining to a communication device to which that device permits a connection, and for reference to the manager 30 selecting an access point 22 that is allowed to**

**communicate with the mobile station 24 based on the stored signal strength measurements).**

**With respect to claims 12 and 26,** Eran et al. discloses performing the determination by means of the first connection device inquiring to another connection device about permission for the communication device to make a connection (See pages 4-5 paragraph 47 and 49-50, and Figure 2A of Eran et al. for reference to each access point 22 inquiring to a manager 30, which is another connection device, about authentication, which is permission, for the mobile station 24 to make a connection).

**With respect to claims 13 and 27,** Eran et al. discloses the first communication device comprising a registering means for registering the communication device performing the inquiry (See page 5 paragraphs 49-52 and Figures 2A and 2B of Eran et al. for reference to the access point 22 registering the mobile station 24 via an authentication request and an association request sent from the access point 22 to the manager 30).

**With respect to claims 15 and 29,** Eran et al. discloses the connection device that received the inquiry from the first connection device updating contents registered in the registering means (See page 5 paragraph 52 and Figure 2B of Eran et al. for reference to the manager 30 updating association information in response to receiving an association request via the access point 22).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eran et al. in view of Arazi et al. (U.S. Pat. 6430395 B2).

**With respect to claims 6 and 21**, Eran et al. does not specifically disclose storing the connection device that the communication device should connect to according to units of time.

**With respect to claims 6 and 21**, Arazi et al., in the field of communications, discloses storing a connection device that a communication device should connect to according to units of time (**See the abstract and column 5 lines 3-21 of Arazi et al. for reference to base stations, which are connection devices, receiving and storing commands indicating the time of day at which the base station should start and stop communicating with a mobile unit**). Storing a connection device that a communication device should connect to according to units of time has the advantage of allowing a predetermined coordinated handoff to occur between base stations at a predetermined and selected time.



It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Arazi et al., to combine storing a connection device that a communication device should connect to according to units of time, as suggested by Arazi et al., with the system and method of Eran et al., with the motivation being to allow a predetermined coordinated handoff to occur between base stations at a predetermined and selected time.

7. Claims 7, 8, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eran et al. in view of Tagg et al. (U.S. Publication US 2005/0286466 A1).

**With respect to claims 7 and 22**, Eran et al. does not specifically disclose notifying information pertaining to multiple connecting devices when it is determined there are multiple connection devices for the communication device to connect to.

**With respect to claim 8**, Eran et al. does not specifically disclose the communication device performing a display to select one of the multiple connection devices notified.

**With respect to claims 7, 8, and 22**, Tagg et al., in the field of communications, discloses a notifying means notifying information pertaining to multiple connecting devices when it is determined there are multiple connection devices for a communication device to connect to and a communication device performing a display to select one of the multiple connection devices notified **(See page 26 paragraph 413 of Tagg et al. for reference to notifying a handset of all available access points in the vicinity, displaying a list of the available access points to a user, and**

**selecting a preferred access point from the displayed list**). Notifying and displaying multiple connection devices for selection has the advantage of allowing a user to have more control over the specific connection devices they wish to connect with.

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Tagg et al., to combine notifying and displaying multiple connection devices for selection, as suggested by Tagg et al., with the system and method of Eran et al., with the motivation being to allow a user to have more control over the specific connection devices they wish to connect with.

8. Claims 9, 10, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eran et al. in view of Suomela (U.S. Pat. 6885362 B2).

**With respect to claims 9 and 23**, Eran et al. does not specifically disclose storing the information separately by the area where the communication device is arranged.

**With respect to claims 9 and 23**, Suomela, in the field of communications, discloses storing information separately by the area where a communication device is arranged (See column 1 lines 53-60, column 4 lines 37-57, column 6 lines 49-59, and Figure 7 of Eran et al. for reference to receiving information concerning a location of a wireless terminal and sending access point information regarding an access point which the terminal should connect to based on the location of the wireless terminal). Storing information separately by the area where a communication device is arranged has the advantage of allowing the proper access point and

corresponding applications to be selected depending on a known location of a communication device.

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Suomela, to combine storing information separately by the area where a communication device is arranged, as suggested by Suomela, with the system and method of Eran et al., with the motivation being to allow the proper access point and corresponding applications to be selected depending on a known location of a communication device.

**With respect to claims 10 and 24**, Eran et al. discloses instructing communication devices to connect to multiple connection devices in an evenly distributed fashion where there are multiple connection devices which the communication device should connect to **(See page 5 paragraph 48 and Figure 2A of Eran et al. for reference to selecting access points 22 for mobile stations 24 to connect to based on load balancing among the access points thereby connecting multiple mobile stations 24 to multiple access points 22 in an evenly distributed fashion)**.

9. Claims 16 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over Eran et al. in view of Morimoto (U.S. Publication US 2002/0041689 A1, a cited on the Applicant's IDS).

**With respect to claims 16 and 30**, Eran et al. does not specifically disclose the first connection device performing the inquiry when the first connection device does not permit the communication device to connect.

**With respect to claims 16 and 30**, Morimoto, in the field of communications, discloses a connection device performing an inquiry when the connection device does not permit a communication device to connect **(See the abstract, page 4 paragraph 38, and Figure 7 of Morimoto for reference to a wireless base station 11 performing an inquiry to another authenticating server when the base station 11 does not permit a terminal station 22 to connect to a network)**. A connection device performing an inquiry when the connection device does not permit a communication device to connect has the advantage of allowing a connection device to gain communication permission from a separate network, when the devices of a wireless network do give communication permission to the connection device.

It would have been obvious for one of ordinary skill in the art at the time of the invention, when presented with the work of Morimoto, to combine a connection device performing an inquiry when the connection device does not permit a communication device to connect, as suggested by Morimoto, with the system and method of Eran et al., with the motivation being to allow a connection device to gain communication permission from a separate network.

***Allowable Subject Matter***

10. Claims 14 and 28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: Claims 14 and 28 would be allowable since none of the prior art of record discloses or renders obvious the claim limitation regarding "the determining means performs the inquiry to a connection device other than the connection device registered in the registering means in a case where the determining means could not determine the connection device which the communication device should connect to after an inquiry made based on the registration in the registering means".

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON E. MATTIS whose telephone number is (571)272-3154. The examiner can normally be reached on M-F 8AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on (571)272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEM

/FIRMIN BACKER/  
Supervisory Patent Examiner, Art Unit 2616